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OCT 02 2006

OFFICE OF PETITIONS

In re Application of :
Wardrop et al. : DECISION ON APPLICATION
Application No. 10/017,483 : FOR
Filed: December 14, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. 130109.431 : .

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)," filed August 2, 2006. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from six hundred sixty-seven (667) days to seven hundred ten (710) days.

The application for patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the notice of allowance is **seven hundred eleven (711)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On May 2, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 667 days. On August 2, 2006, applicants timely submitted the instant application for patent term adjustment¹. Applicants dispute the reduction of 44 days associated with the

¹ PALM records indicate that the Issue Payment was also filed on August 2, 2006.

filing of a supplemental Information Disclosure Statement on August 27, 2003. Applicants assert that the reduction is not warranted because the IDS was filed in compliance with the requirements of 37 C.F.R. § 1.704(d).

Applicants note that this application is not subject to a terminal disclaimer.

As of August 27, 2003, 37 C.F.R. § 1.704(d) provided that:

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

A review of the supplemental IDS filed August 27, 2003 included such a statement. However, instead of stating "each item of information," applicants stated "each of the references set forth on the attached form PTO-1449." Petitioner should track the exact language of § 1.704(d). Nonetheless, in this instance, it is concluded that given the statement therein the filing of the supplemental IDS is not considered a failure to engage and the reduction of 44 days is not warranted.

However, applicants are reminded that, effective May 24, 2004, Section 1.704(d) was amended to change "cited in a communication" to "first cited in any communication" in order to clarify that the item must have been first cited in any communication from a foreign patent office in a counterpart application instead of merely being cited in such a communication. An applicant who fails to cite an item, within thirty days of receipt by an individual designated in Sec. 1.56(c) of a first communication from a foreign patent office in a counterpart application citing the item, and instead files an information disclosure statement, within thirty days of a subsequent communication citing the item, cannot be considered

to have acted with reasonable efforts to conclude prosecution of the application. The change to require that this thirty-day time period run from a first communication parallels the corresponding language in Sec. 1.97(e)(1). The provisions of Sec. 1.704(d) do not apply if the applicant does not submit the information disclosure statement within thirty days of a first communication including a citation of an item to a party designated in Sec. 1.56(c). In such situations, the submission of an information disclosure statement may be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under Sec. 1.704(c)(6), (c)(8), (c)(9), or (c)(10). See Revision of Patent Term Extension and Patent Term Adjustment Provisions, Final Rule, 69 FR 21704 (April 22, 2004).

In view thereof, the reduction of 44 days is being removed.

However, given the clarification set forth in this rule, applicants are reminded of their duty of good faith and candor to the Office. Thus, applicants should advise the Office if the statement made under the previous rule was made within thirty days of a subsequent communication citing the item (rather than "first cited").

Moreover, it is noted that the number of days in the period for the Office delay associated with the Appeal Process is 673 days, not 672 days.

Accordingly, the determination of patent term adjustment at the time of the mailing of the notice of allowance is 711 days.

It is noted that the NOTICE OF NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT mailed August 11, 2006 appears to have been mailed in error. The record before the undersigned indicates that the only IDS "filed" after the payment of the Issue Fee was the copy of the previously filed IDS submitted as evidence in the instant application for patent term adjustment. The Technology Center has been directed to reconsider the propriety of the Notice.

Receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The application is being forwarded to the Office of Patent Publication for timely issuance of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PAIR Screen